

REMARKS

Claims 8-12 and 22-31 were pending in the application at the time the present Office Action was mailed. Claims 8, 22, 25, 29, and 30 have been amended to clarify certain aspects of these claims. Claim 22 has also been amended to correct a minor informality. New claims 45-55 have been added. Accordingly, claims 8-12, 22-31, and 45-55 are now pending in the application.

In the Office Action mailed September 30, 2004, claims 8-12 and 22-31 were rejected. More specifically, the status of the claims in light of the Office Action is as follows:

- (A) Claim 22 was objected to because of a minor informality;
- (B) Claims 8-12, 22, and 23 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 6, 8-10, 13, and 17-21 of U.S. Patent No. 6,644,696 to Brown et al. ("Brown");
- (C) Claims 25-29 stand rejected under 35 U.S.C. § 102(e) as being anticipated by UK Patent Application No. 2,326,866 to Holmes ("Holmes");
- (D) Claims 8-11, 30, and 31 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,116,402 to Beach et al. ("Beach") in view of Holmes; and
- (E) Claims 8-10, 12, and 22-24 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over European Patent Application No. 1,127,593 to Hulleman ("Hulleman") in view of Holmes.

The undersigned attorney wishes to thank the Examiner for discussing the present Office Action in telephone conferences on December 17 and December 20, 2004. The following remarks summarize and expand on the telephone conferences and reflect the agreements reached between the Examiner and the undersigned attorney.

A. Response to the Objection to Claim 22

Claim 22 was objected to on the grounds that "it" at line 9 should be changed to -the third indicia--. Claim 22 has been amended in accordance with the Examiner's suggestion. Accordingly, the objection to claim 22 should be withdrawn.

B. Response to the Obviousness-Type Double Patenting Rejections

Claims 8-12, 22, and 23 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 6, 8-10, 13, and 17-21 of Brown. In the interest of expediting prosecution, and without commenting on or conceding the merits of these rejections, the applicants have elected to provide the enclosed terminal disclaimer. In light of this terminal disclaimer, the obviousness-type double patenting rejection should be withdrawn.

C. Response to the Section 102 Rejection of Claims 25-29

Claims 25-29 were rejected under 35 U.S.C. § 102(e) as being anticipated by Holmes. As the Examiner acknowledged during the December 17 telephone conference, Holmes does not qualify as prior art under Section 102(e) and, accordingly, this should be a § 102(b) rejection rather than a § 102(e) rejection.

The standard for an anticipation rejection under Section 102 requires, among other things, that "each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." (MPEP § 2131; emphasis added.) As discussed below, Holmes cannot support a Section 102 rejection of claims 25-29 for at least the reason that this reference fails to teach or suggest each and every element set forth in the claims.

1. Independent Claim 25 is Directed to a Voucher that Includes, *Inter Alia*, a Substrate Configured to be Dispensed from a Coin-Counting Machine, the Substrate Having a Thermally Responsive Substrate Portion

Independent claim 25 is directed to a voucher configured to assist in distinguishing unauthorized duplicate or counterfeit vouchers. As amended, the voucher of claim 25 includes a substrate configured to be dispensed from a coin-

counting machine. The substrate has a thermally responsive substrate portion configured to change appearance in response to a change in ambient temperature. Specifically, the thermally responsive substrate portion has a first visual appearance at a first ambient temperature and a second visual appearance at a second ambient temperature.

2. Holmes Discloses an Advertising Label Having Thermo-Chromic Ink that Responds to Contact with Water

Holmes discloses an advertising label for attachment to water contacting surfaces of water-receiving receptacles, such as sinks or urinals. (Holmes, Abstract.) The label is formed from a waterproof material and/or coated with a suitable waterproof polymeric material. (Holmes, p. 4.) The label includes a first side having advertising indicia and a second side having a waterproof adhesive used to affix the label to the receptacle. The advertising indicia on the first side of the label includes one or more layers of thermo-chromic ink over an advertising message or logo. The thermo-chromic ink masks the advertisement such that the advertising indicia is substantially invisible and *only appears when the label is contacted by water having a temperature substantially different than the ambient temperature.* (Holmes, p. 2.) As Holmes emphasizes, the thermo-chromic inks "ensure that the advertising indicia do not appear simply as a result of changes in ambient temperature, but only upon contact with water." (Holmes, p. 3; emphasis added.)

3. Holmes Cannot Support a Section 102 Rejection of Independent Claim 25 for at Least the Reason that Holmes Fails to Teach or Suggest Vouchers Having Thermally Responsive Portions Configured to Change Appearance in Response to a Change in Ambient Temperature

Claim 25 is directed to a voucher having a substrate configured to be dispensed from a coin-counting machine. The claimed substrate includes a thermally responsive portion configured to change appearance in response to a change in ambient temperature. In contrast, the thermo-chromic ink of Holmes is specifically selected to not change appearance "simply as a result of changes in ambient temperature, but only upon contact with water." Thus, Holmes expressly teaches away from the thermally

responsive substrate portion of claim 25. Furthermore, the advertising label of Holmes is not "a substrate configured to be dispensed from a coin-counting machine." Accordingly, Holmes does not include "each and every element" of claim 25 and cannot support a Section 102 rejection of this claim. Therefore, the Section 102 rejection of claim 25 should be withdrawn.

Claims 26-28 are allowable as depending from allowable base claim 25, and also because of the additional features of these dependent claims. Accordingly, the Section 102 rejection of claims 26-28 should be withdrawn.

Independent claim 29 includes features generally similar to claim 25, including "a substrate configured to be dispensed from a coin-counting machine." Claim 29 is thus allowable over Holmes for the reasons discussed above with respect to claim 25, and also because of the additional features of this claim. Therefore, the Section 102 rejection of claim 29 should be withdrawn.

D. Response to the Section 103 Rejection of Claims 8-11, 30, and 31

Claims 8-11, 30, and 31 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Beach in view of Holmes. To establish a *prima facie* case of obviousness, the prior art reference (or references when combined) must teach or suggest all of the claimed features. (MPEP § 706.02(j).) As set forth in detail below, the applied references of Beach and Holmes cannot support a Section 103 rejection of claims 8-11, 30, and 31 for at least the reason that these references fail to teach or suggest all the claimed features.

1. Independent Claim 8 is Directed to a Voucher that Includes, *Inter Alia*, a Substrate Configured to be Dispensed from a Coin-Counting Machine, a First Indicia on the Substrate, and a Thermally Responsive Second Indicia on the Substrate

Independent claim 8 is directed to a voucher configured to assist in distinguishing unauthorized duplicate or counterfeit vouchers. As amended, the voucher of claim 8 includes a substrate configured to be dispensed from a coin-counting machine, a first indicia on the substrate, and a thermally responsive second indicia on the substrate.

The thermally responsive second indicia is configured to change appearance in response to a change in ambient temperature.

2. Beach Discloses a System for Detecting Alteration and/or Counterfeiting of Vouchers and other Value Documents

Beach discloses a system for preventing alteration and/or counterfeiting of vouchers. In Figure 1, for example, the voucher of Beach can include information about a coin-counting transaction, including the system name or logo 112, the retail location of the transaction 114, the total value of the coins counted 118, the processing fee 122, and an indication of the voucher's worth 124a, b. A bar code 138 can include a machine-readable version of selected transaction information and a five-digit encrypted number 152. The five-digit encrypted number 152 can be an encryption of the voucher's worth 124a, b. When the voucher is presented for redemption, the number 152 can be decrypted to ensure that the voucher has not been altered.

3. Beach and Holmes Cannot Support a Section 103 Rejection of Claim 8 for at Least the Reason that the Applied References Fail to Teach or Suggest an Indicia Configured to Change Appearance in Response to a Change in Ambient Temperature

Independent claim 8 is directed to a voucher configured to be dispensed from a coin-counting machine. The voucher includes a substrate with a first indicia and a thermally responsive second indicia. The second indicia is configured to change appearance in response to a change in ambient temperature. The Office Action notes that Beach fails to teach or suggest this feature. To overcome this deficiency, the Office Action relies on Holmes. More specifically, the Office Action asserts that Holmes teaches advertising indicia defined by thermo-chromic ink and that it would have been obvious to incorporate the teachings of Holmes into the system of Beach. As discussed above, however, Holmes expressly teaches away from an indicia that responds to changes in ambient temperature. Specifically, Holmes teaches thermo-chromic ink that only responds to water. Therefore, the combination of Holmes and Beach does not teach or suggest all the claimed features. Accordingly, Beach and Holmes cannot support a Section 103 rejection of claim 8 and the rejection of claim 8 should be withdrawn.

The Section 103 rejection of claim 8 should also be withdrawn because the prior art provides no motivation to combine the applied references. The Office Action asserts that it would have been obvious "to incorporate the teachings of Holmes into the system as taught by Beach et al. in order to provide Beach et al. with a more secure system wherein the indicia made it difficult to copy [or] duplicate due to the thermal[ly] responsive ink." (Office Action, p. 7.) The MPEP, however, requires that the prior art provide the basis for combining or modifying references. More particularly, MPEP § 2143.01 states "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." (citing *In re Kotzab*, 217 F.3d 1365, 1371, 55 U.S.P.Q.2d 1313, 1318 (Fed. Cir. 2000)).

Nowhere has the Examiner identified where the prior art suggests combining Holmes with Beach. As discussed above, the thermo-chromic ink of Holmes is responsive "only upon contact with water." Thus, contrary to the Office Action's assertion, a person of ordinary skill in the art would not be motivated to combine the teachings of Holmes with the voucher of Beach because the water required to activate Holmes's thermo-chromic ink would damage or destroy Beach's voucher. Accordingly, the Office Action has failed to establish a *prima facie* case of obviousness because the prior art does not suggest the desirability of the combination. In the event the Examiner maintains this rejection, the applicants respectfully request that the Examiner identify where Beach and/or Holmes provide the motivation for combining the two references. Absent such a cite, the Section 103 rejection of claim 8 should be withdrawn for at least this additional reason.

Claims 9-11 are allowable as depending from allowable base claim 8, and also because of the additional features of these dependent claims. Accordingly, the Section 103 rejection of claim 9-11 should be withdrawn.

Independent claim 30, as amended, includes several features generally similar to claim 8, including "a thermally responsive second indicia on the substrate configured to change appearance in response to changes in ambient temperature." For at least the

reasons discussed above with respect to claim 8, the Section 103 of claim 30 should be withdrawn.

Claim 31 is allowable as depending from allowable base claim 30, and also because of the additional features of this dependent claim. Accordingly, the Section 103 rejection of claim 31 should be withdrawn.

E. Response to the Section 103 Rejection of Claims 8-10, 12, and 22-24

Claims 8-10, 12, and 22-24 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Hulleman in view of Holmes.

1. Hulleman is Directed to a Gift Voucher Including a Game of Chance that may Increase the Value of the Voucher

Referring to Figure 1 of Hulleman, this reference discloses a voucher 1 having a value coupon 3 and an integral game of chance 15. The game of chance 15, for example, can include a scratch section 17 with which the value of the voucher 1 can be increased. The voucher 1 also includes a security system to protect against theft. The security system includes a public code 19 on the value coupon 3 and a private code 21 on a tear-off coupon 7. The two codes 19 and 21 form a unique combination that can be used to verify the authenticity of the voucher 1.

2. Hulleman and Holmes Cannot Support a Support a Section 103 Rejection of Claim 8 for at Least the Reason that these References Fail to Teach or Suggest an Indicia Configured to Change Appearance in Response to a Change in Ambient Temperature

As discussed previously, claim 8 includes a second indicia configured to change appearance in response to a change in ambient temperature. The Office Action correctly states that Hulleman fails to teach or suggest this feature. To overcome this deficiency, the Office Action once again turns to Holmes asserting that "Holmes teaches advertising indicia defined by thermo-chromic ink, which is thermal[ly] responsive indicia." (Office Action, p. 8.) As discussed above, however, Holmes teaches away from the claimed indicia that is responsive to changes in ambient temperature. In contrast to the claimed invention, Holmes teaches that the selected thermo-chromic inks

"ensure that the advertising indicia do not appear simply as a result of changes in ambient temperature, but only upon contact with water." Accordingly, Hulleman and Holmes cannot support a Section 103 rejection of claim 8 for at least the reason that neither of these references teach all of the claimed features. Therefore, the rejection of claim 8 should be withdrawn.

Claims 9, 10, and 12 are allowable as depending from allowable base claim 8, and also because of the additional features of these dependent claims. Accordingly, the Section 103 rejection of claim 9, 10, and 12 should be withdrawn.

Independent claim 22, as amended, includes several features generally similar to claim 8, including "a thermally responsive second indicia on the substrate configured to change appearance in response to changes in ambient temperature." For at least the reasons discussed above, the Section 103 of claim 22 should be withdrawn.

Claims 23 and 24 are allowable as depending from allowable base claim 22, and also because of the additional features of these dependent claims. Accordingly, the Section 103 rejection of claims 22 and 24 should be withdrawn.

The Section 103 rejection of claims 8-10, 12, and 22-24 should also be withdrawn because there is no motivation to combine Hulleman with Holmes. As discussed above, patent law requires that "the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." A person of ordinary skill in the art would not be motivated to combine Hulleman with the system of Holmes that requires water to activate the thermo-chromic ink. As with the vouchers of Beach, placing the voucher of Hulleman in water would damage or destroy the voucher. Thus, the prior art fails to provide the necessary motivation or teaching to combine the applied references. Accordingly, the Section 103 rejection of claims 8-10, 12, and 22-24 should be withdrawn for this additional reason.

F. New Claims 45-55

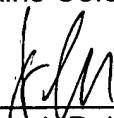
New claims 45-55 have been added by this amendment. Applicants submit that claims 45-55 do not contain any new matter. Claims 45-47 depend from base claim 8, claims 48 and 49 depend from base claim 22, claims 50 and 51 depend from base claim 25, claims 52 and 53 depend from base claim 29, and claims 54 and 55 depend from base claim 30. Therefore, new claims 45-55 are patentable over the applied references for at least the reasons discussed above with reference to corresponding base claims 8, 22, 25, 29, and 30, and for the additional features of these dependent claims.

Conclusion

In view of the foregoing, the claims pending in the application comply with 35 U.S.C. § 112 and patentably define over the applied art. Therefore, a Notice of Allowance is respectfully requested. If the Examiner has any questions or believes another telephone conference would expedite prosecution of this application, the Examiner is encouraged to call the undersigned at (206) 359-3982.

Respectfully submitted,

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